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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/823,663      | 04/14/2004  | Naoto Ohshima        | Q80834              | 4957             |

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EXAMINER

LE, HOA VAN

ART UNIT PAPER NUMBER

1752

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/823,663

Applicant(s)

OHSHIMA, NAOTO

Examiner

Hoa V. Le

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 14-16 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 10/401,893.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

This is in response to Papers filed on 02 November 2005.

I. Applicant files a terminal disclaimer being acknowledged. The claims in application serial no. 10/823,700 do not have the gelatin amount for a patentability as those in the claims of patent no. 6,777,174 and the claims of the instant application and selenium and gold sensitizers in the claims of the instant application.

II. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aylward et al (6,465,164) considered in view of Yamashita et al (5,573,903).

Aylward et al disclose, teach and suggest a color photographic material comprising a support having thereon at least three yellow-, magenta- and cyan-dye forming layers and a non-photosensitive layer with less than 0.5 g/m<sup>2</sup> of silver and the yellow-dye forming layer containing 90 mol% or more of silver chloride. The blue-sensitive silver halide grains are sensitized with sulfur and gold containing compound(s). Please see the whole disclosure of each of the applied references, especially in Aylward et al at col.46:8-22, 47:65 to 48:39, 53:51 to 54:50 and Table 6 on col.58:7 to 59:18.

Aylward et al do not specify blue-sensitive silver halide grains of 0.7 microns or less in a sphere-equivalent diameter as that in claim 1 and those of 0.5 microns in claim 5. However, Aylward et al disclose, teach, suggest and reduce to practice with blue-sensitive silver halide grains having 0.6 microns in an edge length (having 0.75 microns in sphere-corresponding diameter as provided by applicant in the response filed on 02 November 2005). But it is reasonably close and obvious variant to the claimed sphere-corresponding diameter of 0.7 microns in the blue-sensitive layer as claimed in the absence of an unusual or unexpected result. The green-sensitive silver halide grains have 0.30 microns in an edge length (having 0.375 sphere-corresponding diameter as provided by applicant in the response filed on 02 November 2005). The red-sensitive silver halide grains have 0.40 in an edge length (having 0.50 microns in sphere-corresponding diameter as provided by applicant in the response filed on 02 November 2005).

Aylward et al do not specify "selenium" as that in claim 1. Yamashita et al at col.17:61 to 22:60 is cited to show the known use of selenium as the silver halide sensitizing agents. There is no suggestion of Yamashita et al photosensitive silver halide grains and photographic material as thought and urged in the response filed on 02 November 2005.

Since the above references are all related to silver halide photographic materials, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the known use of selenium for a reasonable expectation of obtaining a high sensitive silver halide photographic material as disclosed, taught, suggested and obtained in Yamashita et al.

Applicant's arguments filed 02 November 2005 have been fully considered but they are not persuasive.

Aylward et al disclose, teach, suggest and reduce to practice with blue-sensitive silver halide grains having 0.6 microns (having 0.75 sphere-corresponding diameter or 0.75 micrometer as provided by applicant in the response filed on 02 November 2005. It is reasonably close and obvious variant to the claimed sphere-corresponding diameter of 0.7 in the absence of an unusual or unexpected result.

Yamashita et al at col.17:61 to 22:60 is cited to show the known use of selenium as the silver halide sensitizing agents. There is no suggestion of Yamashita et al photosensitive silver halide grains and photographic material as thought and urged in the response filed on 02 November 2005. Applicant should have shown or provide a convincing evidence that the use of a selenium sensitizer

Art Unit: 1752

provide no sensitivity with Aylward photosensitive silver halide grains as applied on the record.

Applicant provides the showings in Tables 2 and 3 for the patentability of the claims. Such showings should have been properly submitted under Rule 132. However, they are fully considered.

No patentable value is given beyond the tested as provided with respect to the specific tested chemical ingredients and their adjacent homologue and about their tested amount only. The showings are incomplete and much narrower than those in the claims.

It would like to see tested results to be carried out using (1) about 0.000 000 001 and 0.7 microns in sphere-corresponding diameters with any small or tiny amount of silver such as about 0.000 000 001 g/m<sup>2</sup> in a blue-sensitive layer as broadly claimed, about 5 atoms of selenium and about 5 atoms of gold sensitizer per mole of silver halide as broadly claimed, about 3 and 6 g/m<sup>2</sup> of gelatin as broadly claimed and about 0.2 and 5.0 g/m<sup>2</sup> of silver as broadly claimed. At the level of one skilled in the art, it has reasons to believe that the silver halide color photographic materials in Aylward et al Examples with the use of the specific amounts of the chemical ingredients would provide better color image than those with the broadly claimed limitations in the instant claimed. Applicant should show

Art Unit: 1752

or provide a convincing evidence to the contrary for a patentability of the claims in the next response to this Office action in order for it to be considered timely.

III. Claims 2-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The above dependent claims do not further limit the independent claim 1.

IV. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status

Art Unit: 1752

information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le  
Primary Examiner  
Art Unit 1752

HVL  
29 November 2005

HOA VAN LE  
PRIMARY EXAMINER  
